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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,890	12/26/2001	Narayanan Sankarasubbier	4347-4002	8288

7590

08/25/2004

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EXAMINER

SHIPPEN, MICHAEL L

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,890

Applicant(s)

SANKARASUBBIER ET AL.

Examiner

MICHAEL L. SHIPPEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 28, 2004 has been entered.

Claim Rejections - 35 USC § 112¹

Claims 1-5 are rejected under 35 USC §112, first paragraph. The expression "modified montmorillonite K-10 solid acid" lacks support and description in the specification as filed. At best, the specification supports only the specific "modified montmorillonite K-10 solid acid" exemplified in the examples. The single "modified montmorillonite K-10 solid acid" of the examples is modified in a specific manner and is not drawn to generic concept as now claimed. Furthermore, the specification does not enable one to make and use the claimed invention since there is no indication in the specification of how the montmorillonite is modified or how one would obtain such a

¹ The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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"modified montmorillonite K-10 solid acid". Since the specification makes reference to only one specific "modified montmorillonite K-10 solid acid" without an indication of the nature of the modification, it is considered that applicants have also failed to set forth the best mode contemplated by the inventor of carrying out his invention. The only mode disclosed by applicants is as set forth in the specific examples and one cannot repeat the example without knowing which "modified montmorillonite K-10 solid acid" was actually used.

The declaration filed under 37 CFR 1.132 on April 28, 2004 has been carefully considered but not found persuasive. The question here is not simply if "modified montmorillonite K-10 solid acid" is known or which one will work in the instant claimed process. The question here is what is actually disclosed and described in the specification as filed. While some modified montmorillonites are known, there is no indication in the specification which one is used in the examples. These examples contain the only reference to "modified montmorillonite K-10 solid acid" used in the specification. "Modified montmorillonite K-10 solid acid" in a generic sense is not described. Contrary to declarant's assertion, there is no evidence or adequate reasoning given to assume that any and all "modified montmorillonite K-10 solid acid" would work in or be used in the same manner in the claimed process. Nor is there any indication, at all, that the use of the term in the examples in the specification as filed was intended to embrace all of the possible modification now listed in applicants' declaration. In fact applicants own specification indicates that known catalysts, which includes modified clays referred to in lines 4-8 of page 1, are not suitable for the

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claimed process for various reasons listed as items (1) to (6) towards the bottom of page 2 of the specification.

As to declarant's reference to "relevant references therein", such references are not of record nor have they been considered by the examiner. Any statement made by declarant that relies upon "relevant references therein" are considered to be unsubstantiated.

The rejection is not based on the assertion that the method of modification is novel, but, rather, that the actual nature of the modification of the "modified montmorillonite K-10 solid acid" used in the examples is not disclosed. As knowledge by applicants themselves "modified" can embrace a diversity of different embodiments. One cannot be determined the nature of the modification of the montmorillonite K-10 used in the examples from the instant specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen
August 23, 2004



MICHAEL L. SHIPPEN
PRIMARY EXAMINER
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